



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Re Application of)
Richard Francis Russell, et al.) Group: 2142
Serial No.: 09/957,014)
Filed: September 20, 2001)
Title: AUTOMATIC REMOTE ASSIGNMENT OF INTERNET)
PROTOCOL ADDRESS INFORMATION TO A NETWORK) Examiner: B. Prieto
DEVICE)

LETTER AND PETITION UNDER 37 CFR §1.181

MS APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed herewith is the Second Submission Of Replacement Brief of Appellant in the above-identified patent application.

The present Second Submission of Replacement Brief of Appellant is filed in response to a second Notification of Non-Compliant Appeal Brief (37 CFR 41.37), mailed April 23, 2007, which asserts that Appellants' Brief does not comply with 37 CFR 41.37(c)(1)(v).

In particular, it is asserted that Appellants' Brief fails to comply with the provision of 37 C.F.R. 41.37, which requires that for each for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

However, for at least the reasons set forth below, Appellants' respectfully submit that their Brief of Appellant complies with 37 C.F.R 41.37, and accordingly, the Second Submission of Replacement Brief of Appellant provided herewith contains no changes relative to the Replacement Brief of Appellant mailed January 3, 2007.

Appellants thus respectfully request reconsideration of the determination that their Appeal Brief is defective for failure to comply with one or more provisions of 37 CFR 41.37.

37 C.F.R. 41.37(c)(1)(v) is reproduced below for the sake of convenience:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The first sentence of 37 C.F.R. 41.37(c)(1)(v) requires a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.

Appellants have complied with the first sentence of 37 C.F.R. 41.37(c)(1)(v) as set forth in the Summary of Claimed Subject Matter on pages 7-10 of their Replacement Brief of Appellant. The Summary of Claimed Subject Matter includes a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which refers to the specification by page and line number, and to the drawings, by reference characters.

The second sentence of 37 C.F.R. 41.37(c)(1)(v) requires that for each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

However, Appellants respectfully submit that their claims, including their dependent claims, are not in means plus function or step plus function form, as permitted by 35 U.S.C. 112,

sixth paragraph, and hence, the second sentence of 37 C.F.R. 41.37(c)(1)(v) does not apply to Appellants claims.

For example, MPEP 2181(I) sets forth that a claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets a 3-prong analysis, which includes the requirement that (A) the claim limitations must use the phrase “means for” or “step for.”

However, none of Appellants’ claims employ the phrase “means for” or “step for.”

Rather, Appellants’ claims employ the phrases “steps of” and “step of.”

The phrase “steps of” colloquially signals the introduction of specific acts, rather than functions, and should therefore not presumptively invoke application of Section 112, Para. 6. Unlike “of,” the preposition “for” colloquially signals the recitation of a function. Accordingly, the phrase “step for” generally introduces functional claim language falling under Section 112, Para. 6. *Seal-Flex Inc. v. Athletic Track and Court Construction*, 50 USPQ2d 1225, 1234 (Fed. Cir. 1999).

On the other hand, the term “step” alone and the phrase “steps of” tend to show that Section 112, Para. 6 does not govern that limitation, and accordingly, step-plus-function treatment has been denied for method claims which use the conventional “steps of” language. *Seal-Flex Inc. v. Athletic Track and Court Construction*, 50 USPQ2d 1225, 1235 (Fed. Cir. 1999).

In view of the above, Appellants respectfully submit that, because their claim language does not employ “step for” phraseology, Appellants’ claims do not presumptively invoke a 35 U.S.C. 112, sixth paragraph interpretation.

In addition, because Appellants’ claim language employs “steps of” and “step of,” phraseology, Appellants claims tend to show that 35 U.S.C. 112, sixth paragraph, does not govern the limitations therein, and that hence, Appellants’ claims should not be subject to step-plus-function treatment under 35 U.S.C. 112, sixth paragraph.

Thus, Appellants’ dependent claims are not in means plus function form or step plus function form, and hence, the second sentence of 37 C.F.R. 41.37(c)(1)(v), “[f]or each independent claim involved in the appeal and *for each dependent claim argued separately* under the provisions of paragraph (c)(1)(vii) of this section, *every means plus function and step plus* 2001-0158.02/LII0338.US


function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters,” is not applicable to Appellants claims. (Emphasis added).

Because Appellants' Summary of Claimed Subject Matter meets the requirements of the first sentence of 37 C.F.R. 41.37(c)(1)(v), and because the second sentence of 37 C.F.R. 41.37(c)(1)(v) does not apply to Appellants' claims, Appellants respectfully submit that their Brief of Appellant complies with 37 C.F.R 41.37.

Accordingly, Appellants respectfully request that the second Notification of Non-Compliant Appeal Brief (37 CFR 41.37), mailed April 23, 2007, be nullified, and that their Brief of Appellant, submitted herewith, be found in compliance with 37 C.F.R. 41.37.

In the event Appellants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Appellants hereby conditionally petition therefor and authorize that any charges be made to Deposit Account No. 20-0095, TAYLOR & AUST, P.C.

Respectfully submitted,



Paul C. Gosnell
Registration No. 46,735

Attorney for Appellants


"EXPRESS MAIL" Mailing Number EV 620802268 US

Date of Deposit May 23, 2007.

I hereby certify that this paper or fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 CFR 1.10 on the date indicated above and is addressed to the MS APPEAL BRIEF - PATENTS Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Paul C. Gosnell, Reg. No. 46,735

(Typed Name of Person Mailing Paper or Fee)



(Signature of Person Mailing Paper or Fee)

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TAYLOR & AUST, P.C.
12029 E. Washington Street
Indianapolis, IN 46229
Telephone: 317-894-0801
Facsimile: 317-894-0803

Encs.: Return postcard